



HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 200302301-2

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Ronald E. DeLuga

Confirmation No.: 4763

Application No.: 10/737,051

Examiner: Chang, Yean Hsi

Filing Date: 12/16/2003

Group Art Unit: 2835

Title: LATCH ASSEMBLY THAT FACILITATES THE INSERTION AND REMOVAL OF A BATTERY MODULE
FROM AN ELECTRONIC DEVICE

Mail Stop Appeal Brief - Patents
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TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 9/28/2005.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Signature: David M. Hoffman

Respectfully submitted,

Ronald E. DeLuga

By David M. Hoffman

David M. Hoffman

Attorney/Agent for Applicant(s)

Reg No. : 54,174

Date : 11/16/2005

Telephone : (281) 970-4545



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:
Ronald E. DeLuga

Serial No.: 10/737,051

Filed: December 16, 2003

For: Latch Assembly That Facilitates the
Insertion and Removal of a Battery
Module From an Electronic Device

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Group Art Unit: 2835

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David M. Hoffman

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41 AND IN RESPONSE
TO THE EXAMINER'S ANSWER MAILED SEPTEMBER 28, 2005**

This Reply Brief is being filed pursuant to 37 C.F.R. § 41.41 and in response to the Examiner's Answer mailed on September 28, 2005. Specifically, this Reply Brief addresses the Examiner's continuing pattern of misinterpretation of Ohgami et al. (U.S. Patent No. 5,764,477; hereafter "the Ohgami reference") and the pending claims. However, in the interest of brevity, the Appellant addresses below only those issues or arguments raised in the Examiner's Answer that are particularly noteworthy. In view of the Appellant's attempt to avoid repetition in this Reply, the Appellant respectfully requests that the Board consider the Appellant's complete arguments set forth in the previously filed Appeal Brief.

Independent Claims 7, 14, and 22 (rejected under 35 U.S.C. § 102)

As the Appellant has consistently maintained throughout the course of the examination of the present application, several features of independent claims 7, 14, and 22 are simply not disclosed by the Ohgami reference. For example, independent claim 7 recites “a lifter having a sloped structure leading to an inwardly angled structure” and “a boss ... whereat a *mating angled structure* of the boss is retainable against the inwardly angled structure.” (Emphasis added). Independent claims 14 and 22 recite “a lifter having a sloped structure leading to an *angled retention structure*” and a “boss...whereat a mating *angled structure of the boss* is retainable against the angled retention structure.” (Emphasis added).

In sharp contrast, the Ohgami reference clearly discloses structures that are either *flat* or *circular*. More specifically, in the Examiner’s Answer, the Examiner asserts that portion 66 of the Ohgami reference is equivalent to the recited “inwardly angled structure” and the lower end of boss 42 is equivalent to the recited “mating angled structure.” Examiner’s Answer, page 10, lines 1-5. On the contrary, however, the Ohgami reference makes it very clear that portion 66 is *flat* and boss 42 is *circular*. See Figs. 9, 10a, 10b, 11a, 11b, 12, 17, 18a, and 18b. As such, the Appellants are simply unable to understand why the Examiner continues to maintain this rejection based on features that are *by definition* not “angled.” See THE RANDOM HOUSE COLLEGE DICTIONARY, 51-52 (Rev.Ed. 1988) (stating that “angle” is defined as “the space within two or more lines or three or more planes diverging from a common point”). The Ohgami reference with its flat portion 66 and its circular boss 42 clearly does anticipate the above-recited features of independent claims 7, 14, and 22. Accordingly, the Appellant respectfully requests that the Board overturn the Examiner’s rejection of independent claim 7, 14, and 22 and the claims that depend therefrom.

Independent Claims 1, 20, and 29 (rejected under 35 U.S.C. §103)

The Appellants also continue to assert that the Examiner has not established a *prima facie* case of obviousness regarding claims 1, 20, and 29, because the Examiner is yet to provide any suggestion or motivation to modify the Ohgami reference to include a plurality of bosses, as recited in independent claims 1, 20, and 29. Instead, in a conclusory manner, the Examiner has merely asserted that “[i]t would have been obvious...to modify the device of Ohgami with an additional boss and an additional lifter...since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art.” Final Office Action mailed February 1, 2005, Page 7, lines 11-16.

However, as the Board is well aware, to establish a *prima facie* case of obviousness, the Examiner must show that the teachings from the prior art itself suggest the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976). The mere fact that the prior art could be modified as proposed by the examiner is *simply not sufficient* to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). In this case, the Examiner has clearly failed to satisfy the Examiner’s burden, because the Examiner has not explained why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *See id.* In fact, the Examiner has not presented any *evidence* of the requisite motivation or suggestion to modify the Ohgami reference that could lead the ordinary artisan to make the modifications that the Examiner believes “would be obvious.”

Because the Examiner has not provided any suggestion or motivation from the Ohgami reference, the Appellant respectfully asserts that Examiner is attempting to apply a *per se* rule of obviousness. More specifically, the Examiner appears to be applying a *per se* rule that the duplication of parts is obvious. However, as the Board is well aware,

the Federal Circuit has made it clear that “reliance on per se rules of obviousness is legally incorrect and must cease.” *In re Ochiai*, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995). With this in mind, the Appellant respectfully asserts that the Examiner’s conclusory statement does not *demonstrate* that a “plurality of bosses,” as recited in independent claims 1, 20, or 29 is either obvious or well known in the art.

Because the Examiner has not demonstrated a *prima facie* case of obviousness, the Appellant is not required to submit any argument or evidence to rebut such a showing. However, even if the Examiner had demonstrated a *prima facie* case of obviousness, the appropriate legal precedent holds that an alleged duplication of parts is *not* obvious if a new and unexpected result is produced. See *In re Harza*, 124 U.S.P.Q. 378, 380 (C.C.P.A. 1960); M.P.E.P. §2144.04(VI)(B). With regard to the instant application, the Examiner has ignored a number of advantages that the claimed invention presents over the device of the Ohgami reference. For example, a plurality of bosses, as recited in independent claims 1, 20, and 29 provides additional stability to the claimed component mount in comparison to the battery module disclosed in the Ohgami reference. Specifically, the *plurality* of bosses on the component mount supports lifting of the component mount at two or more points thereby improving stability. This enables lifting of the component mount in a smooth and consistent manner such that the module does not tend to tip, cock, or bind as it is repeatedly inserted and removed. Furthermore, the employment of a plurality of bosses also decreases the amount of lifting force applied to each boss because the weight of the component is distributed among the plurality of bosses. This distribution of weight also improves the sliding motion of the component. Appellant further notes that these are but some of the advantages of the claimed invention over the device of the Ohgami reference. Clearly, the claimed invention presents new and unexpected results in comparison to the device of the cited reference, and, as such, is not an obvious “duplication of parts.”

In closing, Appellant reminds the Board again that the Examiner bears the burden of establishing a *prima facie* case of obviousness. With that in mind, the Appellant

respectfully asserts that the foregoing remarks clearly establish that the Examiner has failed to satisfy the proper evidentiary thresholds. Indeed, conclusory statements can simply not satisfy the Examiner's burden. Accordingly, the Appellant respectfully asserts that independent claims 1, 20, and 29, and the claims that depend therefrom, are patentable over the cited reference and in condition for allowance. As such, the Appellant respectfully requests that the Board withdraw the obviousness rejections in relation to claims 1-6, 20-21, 29-32, 33-35, 38-39, and 41-42. Additionally, the Appellant respectfully requests that the Board direct the Examiner to allow these claims.


Conclusion

For each of the reasons set forth above, the Appellant respectfully requests that the Board overturn the Examiner's rejections of independent claims 1, 7, 14, 20, 22, and 29, as well as the claims that depend therefrom.

The foregoing remarks are only clarifying points regarding the reasons why the pending claims are allowable. The Appellant relies upon all of the reasons advanced in the Appeal Brief and respectfully requests that the Board carefully review the claims in view of these arguments and indicate the allowability of the claimed subject matter.

Respectfully submitted,

Date: November 16, 2005



David M. Hoffman
Reg. No. 54,174
(281) 970-4545

CORRESPONDENCE ADDRESS
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400